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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,424	05/18/1999	BERTRAM V. BURKE	EPC-71	5182

7590 11/29/2001

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EXAMINER

JANVIER, JEAN D

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 11/29/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

## Office Action Summary

Application No.

09/314,424

Applicant(s)

BURKE, BERTRAM V.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**Response To Applicant's amendment**

The new title "Method and Means For Providing Rebates" was considered, but not approved. Here is a preferred or suggested title -- Method and System For Providing Rebates from donors to non-profit organizations--. Further, the new abstract was considered, but not approved by the Examiner because of the introduction of new matter, such as transaction between payers and payees, which is not supported in the specification.

Although the Applicant makes reference to claims 1-8, only seven claims are pending in the Application.

Applicant's arguments with respect to **claims 1-7** have been considered but are moot in view of the new ground(s) of rejection. Indeed, claims 2-7 represent new claims that are not yet examined. Further, the superficial argument regarding claim 1 deals with new claim language.

The amendment filed on September 09, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Claims 2-6 recite, among other things, **recording assigned identification to payers, payees and organizations affiliated with the payers and payees during transactions between payers and payees, which is not supported in the specification.**

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Claim 7 recites, among other things, **maintaining a schedule of rebates due from the each of organizations from each of the merchants, which is not supported in the specification.**

Applicant is required to cancel the new matter in the reply to this Office Action.

Therefore, the previous office action rejection regarding claim 1 is still maintained and the present action, as submitted below, has been made final.

#### **\ DETAILED ACTION**

##### ***Specification***

##### **Status of the claims**

Claim 1 was originally presented. After the First Non-final Office Action, claim 1 was superficially amended and claims 2-7 were added. Claims 1-7 are now pending in the Instant Application.

##### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 2-6 recite, among other things, **recording assigned identification to payers, payees and organizations affiliated with the payers and payees during transactions between payers and payees, which is not supported in the specification.**

Claim 7 recites, among other things, **maintaining a schedule of rebates due from the each of organizations from each of the merchants, which is not supported in the specification.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burke, U.S Patent 5,621,640, published on April 15, 1997.

As per claim 1, Burke teaches a method comprising the steps of:

1.

Providing each of a plurality of supporters **or donors** with an individual identification number (ID) **DC1 of fig. 2 or DC2 of fig. 3**. See column 3 and third paragraph;

Entering the (ID) **DC1 or DC2** into an entry terminal **such as Card Reader CDX or Bar Code Reader BCRX of fig. 1**;

Entering an amount spent by a supporter **or donor** at a merchant in a transaction using **Cash Register CRX POS as depicted in fig. 1**. See columns 2-3 and lines 51-72;

Having the entry terminal **Card Reader CDX or Bar Code Reader BCRX of fig. 1** record the (ID) **DC1 or DC2** as well as the amount of dollars spent in a transaction **into the Cash Register CR1 of fig. 1**, which in turn sends the data to CC (central computer) to be stored in DS (data storage) of fig. 1; See columns 2-3 and lines 51-85;

Burke does not expressly disclose the involvement of a clearinghouse in uploading the (ID) and the amount spent by specific donors at a merchant's store, reporting all transaction to a

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merchant for having the merchant send a rebate to a non-profit organization and sending reports to the non-profit organization as to the amount of money spent by supporters or donors at the merchant's store. However, it is understood that the use of a clearinghouse in processing coupon, rebate and voucher redemption data, in a manner well known to those skilled in the art, so that payments can be made to respective parties involved in a particular marketing scheme, such as Cross-selling products, is very popular in the industry. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a third party such as a clearinghouse along with Burke's system so as to upload donors' transaction data including IDs into a clearinghouse computer using the merchant's POS communication system (CS) as depicted by Burke in fig.1, thereby allowing the clearinghouse, upon filtering the data, to report all transaction information back to the merchant's POS central computer CC of fig. 1 via the communication system (CS) in real time so that the merchant can send a rebate to a non-profit organization. This setup significantly reduces not only overhead cost, but also the amount of paper work involved in processing hundreds of donors' or supporters transactions since the whole process is done electronically and in real time. Having a clearinghouse sort out and electronically send data back to the merchant's POS central computer helps increase the efficiency of the system.

Moreover, the clearinghouse system can electronically upload a report into a particular non-profit organization or a Church Computer CHy of fig. 1 regarding the amount of spending completed by the supporters or donors at a given merchant's POS. Upon receiving the report, the Church Treasurer will be able to figure out which Church members have been actively supporting the merchant and communicate this information to the Pastor, who in turn will

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encourage other members to support this particular merchant since the more they spend at the store, the more donations the Church will receive. Sponsoring the store helps the Church raise a great deal of money to support its programs without having to ask the congregation for money. Finally, using this report, the Church Treasurer can compute the amount of money a particular Church member has contributed to the Church through this sponsorship program including other donations so that he can provide, at the end of the year, the member with a receipt, which will allow him or her to deduct the accumulated total upon filing his or her income tax return.

### **Conclusion**

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicant is further directed to consult these references.

US Patent 5,909,794 to Molbak et al is highly considered under a 102 rejection (abstract; col. 2: 30-55).

US Patent 5,905,246A to Fajkowski discloses a clearinghouse for coupon management and redemption.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at  
(703) 305-3900.

. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-746-7238

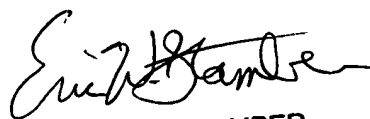
Official Draft-703-746-7239

Non-Official Draft- 703-746-7240

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**Please provide support, that is page and line numbers, for any amended or new claim, otherwise any new claim language that is introduced in an amended or new claim will be considered as new matter.**

11/7/01

  
ERIC W. STAMBER,  
PRIMARY EXAMINER